



Doc Control: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
Attorney Docket No. 09700.0061-00
SAP Reference No. 2003P00321

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number

10/676,846

Filed

September 30, 2003

First Named Inventor

Andreas ROESSLER et al.

Art Unit

2178

Examiner

Samir Termanini

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

s/Krystyna Colantoni/

Signature

☐ assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

Krystyna Colantoni

Typed or printed name

☒ attorney or agent of record.

Registration number 60,226

(202) 408-4314

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

July 9, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the rejection in the Final Office Action mailed on May 15, 2007, the period for response extending through August 18, 2007. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

A pre-appeal brief review of the rejection set forth in the Final Office Action is proper because: (1) the application has been at least twice rejected; (2) Applicants have concurrently filed a Notice of Appeal (prior to filing an Appeal Brief); and (3) this Pre-Appeal Brief Request for Review is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. See Official Gazette Notice, July 12, 2005.

REMARKS

In the final Office action, the Examiner rejected claims 1-4 and 6-21 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,758,087 to Aaker et al. ("*Aaker*"); and rejected claim 5 under 35 U.S.C. § 103 as unpatentable over *Aaker* in view of U.S. Patent No. 5,765,154 to Horikiri et al. ("*Horikin*"). For the reasons set forth below, Applicants respectfully traverse.

Applicants respectfully traverse the rejection of claims 1-4 and 6-21 under 35 U.S.C. § 102(b) as being anticipated by *Aaker*. *Aaker* does not disclose each and every element of Applicants' claimed invention. Claim 1 defines a combination of features including, for example, "[a] computer program product, tangibly embodied in a computer-readable storage medium, comprising instructions operable on a client computer to ... pre-process one or more of the possible user interaction events to generate one or more possible user interface states."

The Examiner alleges that *Aaker*'s "predicted response is generated by the server system 200 using the predict logic module 230" col. 3, lines 22-26." The Examiner argues that

Aaker anticipates the claimed “user interface” by citing to “a client system application program interface [API] 103’ col. 3, lines 60-65.” Final Office action, page 3. However, *Aaker’s* “response” does not include the claimed “one or more possible user interface states.”

When *Aaker* describes an exemplary response, it shows “sequential steps for preparing a predicted response, such as, for imbedded hypertext files begin with preparing a file transfer prediction for a current document as indicated at a block 630” (col. 6, lines 54-57). *Aaker* predicts a file for transfer. *Id.* But, *Aaker’s* transferred file to client system 100 is not, as claimed, “a user interface state” that is “generated” by “pre-processing.” As discussed throughout column 6 of *Aaker*, predicting and preparing a response at block (606) entails following one of the paths shown in Figures 6C and 6D (col 6, lines 2-5). Studying Figure 6C, it shows that preparing a “predicted response” includes “checking for more blocks to transfer” (col. 6, lines 42-44), but does not teach an action “to generate . . . user interface states,” (emphasis added) as recited in claim 1. Studying Figure 6D, drawn to a web server application, it shows that preparing a “predicted response” includes “preparing a file transfer prediction” (col. 6, lines 51-57), but also does not teach any action “to generate . . . user interface states,” (emphasis added) as recited in claim 1.

The Examiner has not shown any action in *Aaker* “to generate one or more possible user interface states,” as recited in claim 1. So, while the Examiner argues that *Aaker* teaches some type of “pre-process” (Final Office action, pages 3-4), the Examiner has not shown where *Aaker* teaches “pre-process one or more of the possible user interaction events to generate one or more possible user interface states,” as recited in claim 1.

In addition, the Examiner has not responded to Applicants’ arguments regarding whether *Aaker* anticipates the claimed generation of “one or more possible user interface states.” The Examiner has offered a grammar lesson directed at the word “generate” in combination with “interaction events.” Final Office action, page 12. However, the Examiner

has not considered the word “to” before the word “generate” in claim 1. The infinitive verb “to generate” creates a positive recitation of an action in the claim which must be anticipated properly by the reference. *Aaker* must not only show an ability to act “to generate user interaction events” (emphasis added), but it must also show an ability to act “to generate one or more possible user interface states” (emphasis added) to anticipate claim 1. Since the Examiner has not shown both acts, the Examiner’s rejection does not anticipate claim 1.

Because *Aaker* does not teach or suggest each and every element recited by amended claim 1, *Aaker* cannot anticipate this claim.

Independent claims 14 and 18, though of different scope from claim 1, recite elements similar to those set forth above for claim 1. Claims 14 and 18 are therefore allowable for at least the reasons presented above. Claims 2-4, 6-13, 15-17 and 19-21 are also allowable at least due to their respective dependence from claims 1, 14 and 18.

In addition to the remarks set forth above regarding the rejections under 35 U.S.C. § 102(b), *Aaker* is additionally deficient with respect to at least claims 3, 16, and 20. Each of these claims require pre-rendering “one or more of the possible user interface states to generate one or more possible user interface appearances.” *Aaker* is silent as to any pre-rendering. The Examiner argues that *Aaker* teaches “imbedded hypertext files . . . for a current [state].” Final Office action, page 11. However, *Aaker* does not teach any rendering to convert the hypertext into a “state,” nor does *Aaker* teach any of the claimed pre-rendering “one or more of the possible user interface states to generate one or more possible user interface appearances.” For at least these reasons, *Aaker* cannot anticipate claims 3, 16, and 20.

Claim Rejection - 35 U.S.C. § 103

Applicants respectfully traverse the rejection under 35 U.S.C. § 103. *A prima facie* case of obviousness has not been established because, among other things, neither *Aaker* nor

Horikiri, taken alone or in combination, teach or suggest each and every element of Applicants' claims.

Dependent claim 5 includes all of the elements of independent claim 1, including, for example "[a] computer program product, tangibly embodied in a computer-readable storage medium, comprising instructions operable on a client computer to ... pre-process one or more of the possible user interaction events to generate one or more possible user interface states." As set forth above, *Aaker* fails to teach or suggest the act "to generate one or more possible user interface states," as required by claim 1.

The Examiner cites *Horikiri* as teaching "that hypertext files are HTML files" (Office action, page 10). Even assuming this allegation is true, which Applicants do not concede, *Horikiri* fails to cure the deficiencies of *Aaker* discussed above. That is, *Horikiri* does not teach or suggest "[a] computer program product, tangibly embodied in a storage medium, comprising instructions operable on a client computer to ... pre-process one or more of the possible user interaction events to generate one or more possible user interface states," as recited in claim 1, and required by claim 5. Moreover, the Examiner has failed to identify any support for this element in *Horikiri*.

Accordingly, *Aaker* and *Horikiri* fail to establish a *prima facie* case of obviousness with respect to claim 5, at least because the references fail to teach or suggest the combination of elements required by the claim.

In view of the foregoing, Applicants respectfully request that the rejection of the claims be withdrawn and the claims be allowed.